

U.S.S.N. 09/827,473
Filed: April 6, 2001
AMENDMENT &
RESPONSE TO OFFICE ACTION

Remarks

Claims 1-25 are pending after entry of the foregoing amendment.

Claims 1, 21, 24, and 25 have been amended. Claims 1, 21, and 24 have been amended to more clearly specify that the locking tabs are adapted to secure the device by *snap-fit or slide-lock* engagement. Similarly, claim 25 has been amended to specify that the tabs clip the device within the vent, without the need for screws. Support for this amendment is found throughout the specification, particularly at page 5, lines 11-13; page 6, lines 8-10; page 8, lines 4-7; and FIGS. 1-5.

Restriction Requirement

The Office Action divided claims 1-25 into two groups: Group I, claims 1-20 and 23-25, drawn to a catalytic converter device for use in a vent; and Group II, claims 21 and 22, drawn to a method of reducing smoke and volatile compounds in a gas flowing through a vent. Applicants elect, with traverse, to prosecute Group I, claims 1-20 and 23-25.

Applicants traverse on the grounds that the Office Action is plainly wrong in asserting that “the process *as claimed* can be practiced by another materially different apparatus such as the use of a wet scrubber other than the use of a ceramic substrate with a catalyst coating.” (emphasis added). The *claimed* process (claim 21) requires the use of an apparatus having all of the same limitations as the claimed catalytic converter device (claim 1). Use of a wet scrubber therefore would not be practicing the process as claimed. Accordingly, Groups I and II should be considered together in one patent application.

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Rejection Under 35 U.S.C. § 102/103

Claims 1-5, 8-10, 19-20, and 23 were rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious over, U.S. Patent No. 3,785,778 to Burstein (hereinafter “Burstein”). The rejection is respectfully traversed, if applied to the claims as amended.

Applicants have developed an improved catalytic converter device, which includes a mounting ring that simultaneously serves to protect the ceramic substrate during installation and maintenance of the catalytic converter and advantageously provides a means for quick and easy installation of the device in an oven. In particular, the mounting ring of applicants’ claimed device includes locking tabs adapted to secure the device by *snap-fit or slide-lock* engagement, such that screws are not required to mount the device within the vent.

Burstein, in contrast, clearly fails to disclose locking tabs or any other securing means that could remotely be construed as including *snap-fit or slide-lock* engagement of a mounting ring. The Office Action mischaracterizes the flange 63 of the Burstein device as being a locking tab. This flange clearly is not a locking tab as defined by the present applicants, because the flange 63 is not mounted by *snap-fit or slide-lock* engagement. Rather, Burstein discloses that flange 63 is secured by screws to mount the catalytic unit to the wall of the oven (Col. 7, Lines 12-15). Accordingly, Burstein clearly fails to disclose or suggest all of the limitations of the presently claimed devices and methods. Burstein is precisely the type of prior art device over which the present invention improves.

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Rejections Under 35 U.S.C. § 103

Claim 6 was rejected under 35 U.S.C. § 103 as obvious over Burstein in view of U.S. Patent No. 3,536,457 to Henderson (hereinafter “Henderson”). Claim 7 was rejected under 35 U.S.C. § 103 as obvious over Burstein in view of applicants’ prior art admission at page 7, lines 11-21. Claims 11-16 were rejected under 35 U.S.C. § 103 as obvious over Burstein in view of U.S. Patent No. 5,934,268 to Onocki (hereinafter “Onocki”). Claims 17 and 18 were rejected under 35 U.S.C. § 103 as obvious over Burstein in view of U.S. Patent No. 5,285,640 to Olivo (hereinafter “Olivo”). Claims 24 and 25 were rejected under 35 U.S.C. § 103 as obvious over DE 019912453 A1 to Mlotek et al. (hereinafter “Mlotek”) in view of Burstein. The rejections are respectfully traversed, if applied to the claims as amended.

Claims for an invention are not *prima facie* obvious if the primary references do not suggest all elements of the claimed invention and the prior art does not suggest the modifications that would bring the primary references into conformity with the application claims. In re Fritch, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992); In re Laskowski, 871 F.2d 115 (Fed. Cir. 1989). The Office Action does not set forth a *prima facie* case of obviousness with respect to the claims as amended.

“Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.” ATD Corp. V. Lydall, Inc., 159 F.3d 534, 546 (Fed. Cir. 1998). Only in hindsight of applicants’ disclosure would one of ordinary skill in the art be led to somehow combine and extend the disclosure of Burstein, alone or in combination with Henderson or Onocki or Olivo, to somehow derive the presently claimed devices and methods. In particular, nothing in these references,

alone or in combination, would have led one of ordinary skill in the art to modify the Burstein device to derive a catalytic converter device having a mounting ring that includes locking tabs adapted to secure the device within a vent by *snap-fit* or *slide-lock* engagement.

The CAFC has warned that “the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for showing of the teaching or motivation to combine prior art references.” In re Dembiczak, 175 F.3d 994 at 999 (Fed. Cir. 1999). While the suggestion to combine may be found in explicit or implicit teachings within the references, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved, the “question is whether there is something in the prior art *as a whole* to suggest the desirability, and thus the obviousness, of making the combination.

WMS Gaming, Inc. v. International Game Technology, 184 F.3d 1339 at 1355 (Fed. Cir. 1999).

“The range of sources available, however, does not diminish the requirement for **actual evidence**. That is, the showing must be **clear and particular**.” In re Dembiczak, 175 F.3d 994 at 999 (Fed. Cir. 1999) (emphasis added). The Office Action does not provide the required clear and particular showing that the prior art as a whole suggests the desirability, and thus the obviousness, of making the claimed combination of elements. Rather, the Office Action’s rationale is conclusory, indicating that it would be obvious to combine the art to achieve the benefits taught and claimed by the applicants. That in hindsight of applicants’ disclosure a skilled artisan arguably may be able to recognize, cull, modify, and combine certain claim elements from disparate references is not evidence of a clear and particular motivation to combine those references.

With respect to claims 24 and 25, Mlotek discloses a filter housing 53 which consists of a base part 57 and a cover part 59. The cover 59 is secured *to the vent 47 by screws*, which extend through holes 51 in the wall of the vent 47 and into threaded holes 65 in the cover 59. (See FIG. 2 and page 5, lines 16-18 of the English language translation of the German patent document). However, Mlotek fails to disclose or suggest a device in which the *catalyst is secured within a mounting ring* by the use of one or more retaining tabs extending from the mounting ring. Furthermore, Mlotek fails to disclose or suggest a device having locking tabs extending from the mounting ring, wherein the locking tabs are engageable *by snap-fit or slide-lock engagement with the vent to secure the catalytic converter device within an orifice of the vent*. Accordingly, Mlotek fails to suggest all of the limitations of applicants' claimed devices.

Burstein fails to supplement Mlotek's deficiencies. Only in hindsight of applicants' disclosure would one of ordinary skill in the art be led to somehow combine and extend the disclosures of Mlotek and Burstein to somehow derive the presently claimed devices and methods. The prior art, as a whole, fails to suggest the claimed combination of elements defined by applicants' claims, and no "particular finding" supports a *prima facie* case of obviousness.

While not necessary to establish patentability, secondary considerations also indicate that the presently claimed devices are nonobvious. Applicants note that the oven making industry has for many years prior to applicants' invention utilized screws to mount catalytic converter devices into ovens. However, since the disclosure of applicants' invention, the oven making industry has rapidly accepted and readily adopted applicants' devices which are secured by snap-fit or slide-lock engagement into the vents of the ovens.

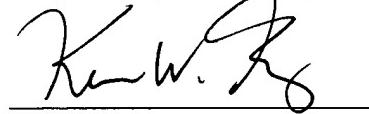
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Conclusions

For the foregoing reasons, applicants submit that the claims are novel and nonobvious over the prior art of record, and that the Office Action does not set forth a *prima facie* case of anticipation or obviousness of claims 1-25 as amended. Allowance of claims 1-25 is therefore respectfully solicited.

The undersigned respectfully invites the Examiner to contact him by telephone (404.853.8068) if any outstanding issues can be resolved by conference or examiner's amendment.

Respectfully submitted,



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